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Paper No. 26

In re Application of	:	
Michael C Scroggie et al.	:	DECISION ON RENEWED PETITION
Application No. 09/401,939	:	UNDER 37 C.F.R. 1.181 TO REMOVE
Filed: September 23, 1999	:	FINAL STATUS
For: SYSTEM AND METHOD FOR	:	
PROVIDING SHOPPING AIDS	:	
AND INCENTIVES TO	:	
CUSTOMERS THROUGH A	:	
COMPUTER NETWORK	:	

This is a decision on the renewed petition under 37 CFR 1.181 filed August 12, 2003 (Paper No. 22) for removal of the final status (Final rejection), made FINAL in Paper No. 13 (mail date November 22, 2002). (The petition is entitled "request for reconsideration of decision under 37 CFR 1.181 petition to remove final status, paper no. 20, mailed July 25, 2003.")

CASE HISTORY

This application was filed on September 23, 1999, with originally presented claims 1-31. The Preliminary Amendment, filed concurrently with the application, cancelled claims 1-31 and presented claims 32-70.

The Examiner issued a first, non-final rejection in an Office action mailed to Applicant on July 29, 2002 (Paper No. 6). This action included a rejection of the pending claims under 35 USC 103(a) as being unpatentable over "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike)" and included a rejection taking Official Notice of certain facts that were in the Examiner's knowledge "since at least 1994."

In Paper No. 12, filed October 23, 2002, Applicant filed a response amending claims 32-34, 37-43, 58-60, and 63-69. Applicant included argument that "[T]he examiner did not provide a declaration of his personal knowledge of the PerformanceBike.com web site, pursuant to MPEP 2144.03 and 37 CFR 1.104(d)(2). Therefore, the examiner's non-

declaration factual assertions are not probative. ... if the examiner does provide a declaration and maintains these rejections, I will request that Mr. Ruggeri [the web master of PerformanceBike.com] provide a corresponding declaration."

In Paper No. 13, mailed November 22, 2002, the Examiner issued a Final rejection and provided an "Affidavit Supporting Obviousness Rejection" which substantially repeats the statements that were made in relation to Official Notice in the first, non-final office action.

In Papers No. 16, 17, and 18, filed March 14, 2003, Applicant filed, respectively, a Notice of Appeal, Appeal Brief, and Petition under 37 CFR 1.181 to Remove the Final status.

In Paper No. 20, mailed July 25, 2003, the Office issued a petition decision dismissing the consideration of evidence as premature and denying the removal of the Final rejection status.

In Paper No. 21, mailed August 25, 2003, the Examiner issued an Examiner's Answer.

RELIEF REQUESTED

The petition under 37 CFR § 1.181 states that "[T]he applicant requests reconsideration of the decision denying the petition to have the final status removed to the extent necessary to admit the evidence attached to the applicant's appeal brief."

REGULATIONS AND PRACTICE

37 C.F.R. § 1.181 states in part:

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner.

MPEP § 2144.03(C) states in part:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to

some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

MPEP § 2144.03(D) states:

If the examiner adds a reference in the next Office action after applicant’s rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant’s amendment of the claims, the rejection may not be made final. See MPEP § 706.07(a).

37 CFR 1.104(d)(2) states:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

37 CFR 1.192(a) states in part:

Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

and MPEP 1206(8) (referring to this sentence) states:

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief. It should be noted that arguments not presented in the brief and made for the first time at the oral hearing are not normally entitled to consideration. In *re Chiddix*, 209 USPQ 78 (Comm’r Pat. 1980); *Rosenblum v. Hiroshima*, 220 USPQ 383 (Comm’r Pat. 1983).

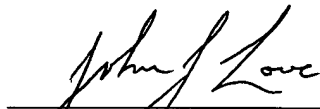
OPINION

Applicant is attempting to get the finality of the rejection of Paper No. 13 withdrawn in order to get the evidence submitted with the appeal brief (Appendix II of the Brief, consisting of 9 attachments) entered and considered.

With regard to both issues, the evidence submitted in conjunction with the appeal brief was entered and considered in drafting the Examiner's Answer of Paper No. 21. Therefore the petition is **DISMISSED AS MOOT** in this regard.

If the petitioner desires further review of the Director's Decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 CFR §1.181(a)(3).

Summary: *Petition Dismissed as Moot*



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EWS 1/20/04